

AUG 22 2006

Application Serial No. 09/944,572

**REMARKS**

1. Applicant thanks the Examiner for her remarks and observations which have greatly assisted Applicant in responding. Applicant also appreciates the Examiner's pointing out the allowable subject matter in the claims.

2. Claims 23, 29, 30 and 43-45 are objected to based on a number of informalities. Responsive thereto, Applicant corrects each of the informalities noted. The objections to the claims are therefore deemed overcome.

3. **35 U.S.C. § 112**

Claims 1-8, 15-17, 33, 35 and 38-45 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out and specifically claim the subject matter of the invention. While Applicant concedes that some of the Examiner's findings may have merit, Applicant also believes that the standard for antecedent basis applied by the Examiner is out of step with current practice as determined by the MPEP and recent legal precedent.

According to MPEP § 2173.05(e), "Obviously . . . the failure to provide explicit antecedent basis for terms does not always render a claim indefinite." Recent cases from the Federal Circuit indicate that the test for indefiniteness is whether or not the scope of the claim could be ascertained by the ordinarily-skilled practitioner. For example, the Federal Circuit held, in *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359 (Fed. Cir. 2001) that despite the lack of antecedent basis, "If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." Thus, if the scope of the claim can be reasonably determined, it is unnecessary to provide verbatim antecedent for a claim element. Applicant sees, for example, no basis for a finding that the expressions "said element for predictive . . ." and "said element for adaptive . . ." in claim 1 lack antecedent basis. While the antecedent is not verbatim, the ordinarily-skilled practitioner would readily understand the meaning and scope of the claim, even without explicit, verbatim antecedent.

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However, while the Examiner has provided no explanation for the finding that the expressions lack antecedent basis in claim 1, Applicant has amended claim 1 with the hope that the amendment will satisfy the standard applied herein, although it is Applicant's belief that the applied standard has been superseded by recent legal precedent and the procedural guidelines of the MPEP.

Additionally, in the interest of advancing prosecution of the application, applicant amends the remaining claims as requested by the Examiner to provide explicit, verbatim antecedent in all instances pointed out.

The term "input" in line 15 of claim 33 has been amended to "input patterns," to make it clear that input patterns, which input patterns include data and masking steps (claim 33, line 7), and masking patterns are applied to the complex circuit. Thus, it is clear that masking steps and masking patterns comprise distinct claim elements.

All rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph are deemed overcome.

### CONCLUSION

In view of the foregoing, the application is deemed to be in allowable condition. Therefore, reconsideration and prompt allowance of the claims is earnestly requested. Should the Examiner have any further questions regarding the application, she is respectfully urged to contact applicant's attorney at 650-474-8400.

Respectfully submitted,



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